

## **REMARKS**

Claims 1-7, 17, 19, 24, 32-44, 46-50, and 54-73 are now in the application. Claims 1-7, 17, 19, 24, 32-37, 39-44, 46-50, and 54-61 have been amended herein. Claims 16, 18, 26-31, 45, and 51-53 are cancelled herein and claims 8-15, 20-23, and 25 were canceled in previous Response(s). Claims 62-73 have been added herein. No new matter has been added.

### **Interview**

Applicant appreciates the courtesy extended by Examiner Tyson for the telephonic interview conducted on November 17, 2011. Applicant has carefully considered the Examiner's comments. Amendments made herein are for the purpose of advancing prosecution but are independent of patentability.

### **35 USC 112, First Paragraph**

Claims 1-7, 16-19, 24, 32-44, 46-50, and 54-59 has been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office alleges that Applicant failed to disclose the elongate body having a "non-expandable portion." Applicant respectfully disagrees.

According to MPEP 2163.02, to determine compliance with the written description requirement "the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the

claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). ... The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” Therefore, a figure may satisfy the written description requirement without the subject matter being literally described in the specification.

Referring to the first paragraph of page 3 of the Office Action, the Office alleges that “applicant failed to disclose the elongate body having a ‘non-expandable portion.’ Therefore, the limitation is considered new matter. For examination purposes the limitation is interpreted as an elongate body as illustrated in Figure 9. It is recommended that applicant utilize terminology utilized in the specification for defining the body as shown in Figure 9.” Applicant respectfully disagrees.

Applicant asserts that “non-expandable portion” of claims 1 and 40 is not new matter, because it is disclosed throughout the application as originally filed, for example, see Figs. 9-15. Because this subject matter is disclosed in, for example, at least Figs. 9-15, it would be improper to limit its interpretation to Figure 9 alone, as suggested by the Office. Furthermore, Applicant asserts that there is no requirement or recommendation in MPEP 2163 to “utilize terminology utilized in the specification”. Therefore, Applicant asserts that this rejection of claims 1 and 40 improper.

Although Applicant respectfully disagrees with the Office, at least claims 1 and 40 have been amended herein to remove “non-expandable portion” to advance prosecution but for reasons independent of patentability. Therefore, this rejection is also moot.

Accordingly, 1-7, 16-19, 24, 32-44, 46-50, and 54-59 meet the requirements of 35 U.S.C. § 112, first paragraph. Therefore, Applicant respectfully requests withdrawal of these rejections.

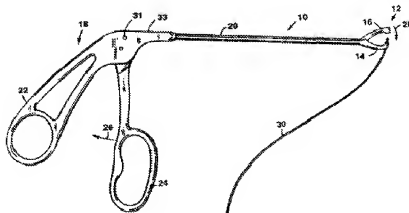
**35 USC 103**

**Ek and Francischelli**

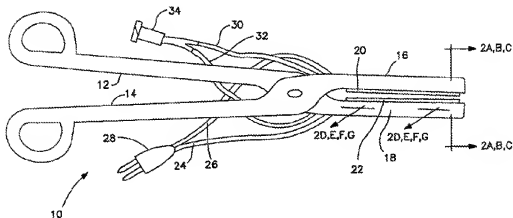
Claims 1-7, 16-19, 24,32-42,44,46-50, and 54-59 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Ek et al. (U.S. Patent No. 5,730,747) and Francischelli (U.S. Patent No. 6,699,240 82).

As an initial matter, as discussed in previous Response(s), Francischelli was filed December 12, 2001, which is after the priority date of this application, but claims the benefit of a provisional application filed April 26, 2001. Applicant expressly reserves the right to swear behind Francischelli.

Ek, alone and in combination, fails to disclose every element of the currently recited claims. On page 4 of the Office Action, the Office alleges that Ek discloses “a magnetically manipulatable distal end (12)”, but Applicant respectfully asserts that “magnetically” is disclosed nowhere in Ek. Ek discloses that “a suture passing forceps 10 ... includes a suturing assembly 12 having a suture holder 14 for removably holding a needled suture 30, and an actuable member 16. Actuable member 16 is pivotably supported by a support shaft 20. ***A handle 18 connected to support shaft 20 is used to actuate actuable member 16.***” (Emphasis Added). C4L10-17. See Fig. 1 below. Therefore, Ek fails to disclose, *inter alia*, a magnetically operable distal end.



Francischelli, alone and in combination, fails to disclose every element of the currently recited claims. Francischelli discloses “magnetically attracting ... first and second components [jaws 16 and 18]” that require either handles 12 and 14 or handles 212 and 214. See Abstract and Fig. 1 below. Furthermore, “[t]he polarities of the magnets correspond to “N” and “S” markings as illustrated, arranged such that the jaws 16 and 18 are attracted to one another along their lengths. ... The magnets also assist in compressing the jaws of the hemostat along their length, assuring good contact with the tissue along the length of the jaws.” See C4L15-24. Therefore, Francischelli teaches jaws 16 and 18 that are mechanically by handles 12 and 14 and magnets that “assist in compressing the jaws”.



Nowhere does the combination of Ek and Francischelli disclose, *inter alia*, 1) an elongate body having a magnetically operable distal end and 2) wherein the first or second engaging member is configured to be attracted or repelled relative to the other engaging member by a magnetic field alone, as currently recited in claim 1. Furthermore, nowhere does the combination of Ek and Francischelli disclose, *inter alia*, 1) an elongate body having a non-mechanically actuated portion and 2) wherein a magnetic field moves the first engaging member relative to the second engaging member, as currently recited in claim 40. Therefore, the combination of Ek and Francischelli fails to teach or suggest every element of claims 1 and 40.

According, Applicant asserts that claims 1, 40, and their dependents are patentable over the cited references. Therefore, Applicant respectfully requests withdrawal of this obviousness rejection.

**Ek and Francischelli in view of Wilkinson**

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ek and Francischelli further in view of Wilkinson (U.S. Patent No. 3,577,991).

Nowhere does the combination of Francischelli and Wilkinson disclose, *inter alia*, 1) an elongate body having a non-mechanically actuated portion and 2) wherein a magnetic field moves the first engaging member relative to the second engaging member, as currently recited in claim 40.

According, Applicant asserts that claim 40 is patentable over the cited references. Therefore, Applicant respectfully requests withdrawal of this obviousness rejection.

In light of the forgoing, Applicant requests withdrawal of the rejections under section 35 USC 103 and allowance of the currently recited claims.

**Double Patenting Rejection**

Claims 1-7, 16-19, 24, 32-36, 38, 44, 49, 50, 54, 55, and 58 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-26 of U.S. Patent No. 6,719,765 B2 ("Patent '765"). Furthermore, claims 37, 39-43, 46, 49, 50, 56, 57, and 59 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-26 of Patent '765 in view of U.S. Patent No. 3,577,991 (Wilkinson).

Applicant has requested that this rejection be held in abeyance until all other issues regarding patentability are resolved. As a preliminary note, the currently recited claims are at least patentably distinct from Patent '765 for not reciting all the acts required by Patent '765's

method claim 1, claims 11-20 depending from method claim 1, and method claims 22-26. Should the claims be further amended during prosecution, the amended claims may not require a terminal disclaimer. Alternatively, if the Office determines that a conflict remains, Applicant will consider the filing of a timely terminal disclaimer.

### **Conclusion**

In view of the foregoing, reconsideration and allowance of claims 1-7, 17, 19, 24, 32-44, 46-50, and 54-73 are solicited.

A fee for appropriate extensions is enclosed herewith. If a further extension of time for this paper is required, petition for extension is herewith made. No other fees are believed to be due for this submission. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 780-A04-002-1).

Respectfully submitted,

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